

REMARKS

At the outset, the Examiner is thanked for the thorough review and consideration of the pending application. The Final Office Action dated December 31, 2008 has been received and its contents carefully reviewed.

Claims 1 and 4 are hereby amended. No new matter has been added. Accordingly, claims 1, 2, and 4-9 are currently pending. Reexamination and reconsideration of the pending claims are respectfully requested.

The Office Action rejects claims 1, 2, and 4-9 under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Office Action states the phrase “1 to 4 carbon atoms substituted or unsubstituted with fluorine” in claims 1 and 4 is unclear. Applicants have amended claims 1 and 4 to more clearly define claimed subject matter. Applicants, therefore, respectfully request withdrawal of the rejection.

The Office Action rejects claims 1-2 and 4-9 under 35 U.S.C. §103(a) as being anticipated by U.S. Patent Application Publication No. 2001/0055892 to Nishikawa et al. (*Nishikawa*). Applicants respectfully traverse the rejection.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *Nishikawa* does not teach or suggest each and every element of claims 1-2 and 4-9, and thus cannot render these claims obvious.

Amended claim 1 recites, “the weight average molecular weight of the resins is at least 5,000.” *Nishikawa* fails to teach at least this element of claim 1. In fact, the Office Action admits that *Nishikawa* “fails to teach that the MW is at least 5000.” *Office Action*, page 4. The Office Action then states that “it would have been obvious to optimize the MW because the NW is known to affect the properties of a coating film.” *Id.* Applicants respectfully disagree. Applicants note that the Office has appeared to have asserted Official Notice that it is well known to affect the properties of a coating film by MW. Official Notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. See M.P.E.P. §2144.03(A). It is never appropriate to rely

solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). In the present case, there is no teaching or suggestion in *Nishikawa*, or apparent knowledge in the art, that NW affects the properties of a coating film. If the Office maintains the this rejection, Applicants request the Office support the assertion of Official Notice with adequate documentary evidence. See M.P.E.P. §2144.03(C).

Accordingly, claim 1 is allowable over *Nishikawa*. Claims 2 and 4-9, which variously depend from claim 1, are also allowable for at least the same reasons as claim 1. Applicants, therefore, respectfully request withdrawal of the rejection.

The Office Action rejects claims 1, 2, and 4-9 under 35 U.S.C. §103(a) as being obvious over KR 20020097415 (*KR 415*). Applicants respectfully traverse the rejection.

Claim 1 recites, “a hydrolysis and condensation reaction of silane compounds comprising one or more kinds of hydrosilane compounds in the presence of a base catalyst.” *KR 415* fails to teach or suggest at least this element of claim 1. In fact, *KR 415* specifically discloses using an acid catalyst (hydrochloric acid) in Examples 1-2 and Comparison 1. *KR 415 English Translation*, page 19, line 13, to page 22, line 8. Furthermore, the Specification provides that “it is desirable to use a base catalyst”, and the use of the base catalyst in the hydrolysis and condensation reaction yields superior and unexpected results. *Specification*, page 8, lines 7-11, and page 12, line 20. Specifically, preferred embodiments 1 and 2 of the present application were prepared in the presence of a base catalyst (methylamine) and have a dielectric constant of 2.24 and 2.48, respectively. *Specification*, page 21, Table 1. Examples 1 and 2 of *KR 415* were prepared in the presence of an acid catalyst (hydrochloric acid) and have a dielectric constant of 2.51 and 2.56, respectfully, which are higher than the dielectric constants of preferred embodiments 1 and 2 of the present application. *KR 415 English Translation*, page 23, Table 1. Accordingly, claim 1 is allowable over *KR 415*. Claims 2 and 4-9, which variously depend from claim 1, are also allowable for at least the same reasons as claim 1. Applicants, therefore, respectfully request withdrawal of the rejection

The Office Action rejects claims 1, 2, and 4-9 under 35 U.S.C. §103(a) as being obvious over KR 20030000709 (*KR 709*). Applicants respectfully traverse the rejection.

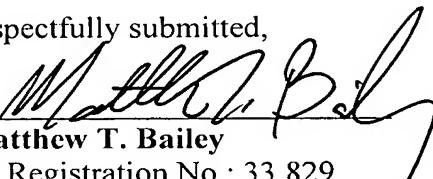
Claim 1 recites, “a hydrolysis and condensation reaction of silane compounds comprising one or more kinds of hydrosilane compounds in the presence of a base catalyst.” *KR 709* fails to teach or suggest at least this element of claim 1. In fact, *KR 709* specifically discloses using an acid catalyst (hydrochloric acid) in Practical Example 1 and Comparison Examples 1 and 2. *KR 709 English Translation*, page 16, line 9, to page 18, line 14. Practical Example 1 of *KR 709* was prepared in the presence of an acid catalyst (hydrochloric acid) and has a dielectric constant of 2.71, which is higher than the dielectric constants of preferred embodiments 1 and 2 of the present application. *KR 709 English Translation*, page 20, Table 1. Accordingly, claim 1 is allowable over *KR 709*. Claims 2 and 4-9, which variously depend from claim 1, are also allowable for at least the same reasons as claim 1. Applicants, therefore, respectfully request withdrawal of the rejection

The application is in condition for allowance and early, favorable action is respectfully solicited. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: April 29, 2009

Respectfully submitted,

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